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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLEG STENZEL, ANKE BLUME,
HANS-DETLEF LUGINSLAND, STEFAN UHRLANDT,
and ANDRE WEHMEIER

Appeal 2010-005553
Application 10/542,763
Technology Center 1700

Oral Hearing Held: October 13, 2010

Before CHARLES F. WARREN, MARK NAGUMO, and KAREN M. HASTINGS, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

HARRIS A. PILICK, ESQUIRE
Oblon, Spivak, McClelland, Maier & Neustadt, LLP
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000

1 The above-entitled matter came on for hearing on Wednesday, October 13,
2 2010, commencing at 1:27 p.m., at the U.S. Patent and Trademark Office,
3 600 Dulany Street, Alexandria, Virginia, before Victoria L. Wilson, Notary
4 Public.

5 THE USHER: Calendar number 25. Appeal number 2010-005553.

6 Mr. Pitlick.

7 JUDGE WARREN: Good afternoon, Mr. Pitlick.

8 MR. PITLICK: Good afternoon.

9 JUDGE WARREN: Ms. Vicky Wilson is our court reporter today. If you will
10 kindly provide her with a business card.

11 MR. PITLICK: Certainly will.

12 JUDGE WARREN: As you know, sir, you have 20 minutes. You may begin
13 when ready.

14 MR. PITLICK: Thank you.

15 Okay. What we have here is an invention drawn to a precipitated silica having
16 various physical and chemical properties, as recited, and there are a number of
17 rejections under 35 USC Section 103, namely two which are such rejections,
18 and a provisional rejection on grounds of obviousness type double patenting.
19 The gist of the invention here and how it distinguishes from the prior art is
20 discussed on page four of the Appeal Brief. I'll just briefly indicate what we
21 say. We say, number one, we discovered that by precipitating at a constant
22 value of -- a constant alkali value, we can obtain precipitated silica having
23 various improved properties.

24 The other significant discovery by our inventors is that normally when you
25 make these kinds of materials, precipitated silica, you are going to have a
26 certain silanol content on the surface, so that the higher the surface area, and

1 now we are talking about BET, which is one of the physical properties in the
2 claims, that the number of silicone -- number of -- excuse me -- the number of
3 silanol groups as a function of the surface area can be increased. The number
4 of -- the absolute number of silanol groups is correlated directly with the Sears
5 value.

6 So the most important and significant limitation of the claims has to do with
7 the ratio of the Sears value to the BET surface area, and we have highlighted
8 that, actually, at pages three and four of the Appeal Brief. That's a significant
9 difference that you can, in effect, increase this ratio or increase the Sears value
10 at a constant BET surface area.

11 I might also point out that we mentioned that there was a related case that we
12 mentioned in the Appeal Brief. That case has been decided. The issues are
13 substantially the same in that case and in that case, the rejections were
14 reversed. And I would argue that, if not res judicata, it's certainly pretty close
15 to almost mandating the same result in this case because the issues are the
16 same.

17 The references relied on were pretty much the same. The main references
18 were this Esch, et al., reference and Uhrland, et al., reference. We have
19 comparative data here, which I'm not going to get into because I mean -- I
20 don't think anything needs to be added to what was already stated in the Briefs.
21 JUDGE WARREN: So you do have evidence of unexpected results with
22 respect to your -- to the ratio?

23 MR. PITLICK: Let's say evidence of patentability because I don't recall that
24 we -- I'm pretty sure we did not ever make a concession that there was a prima
25 facie case. But just to indicate the real world effect of this kind of feature.

26 JUDGE WARREN: So the subset of precipitated silicas that you are

1 claiming

2 here are defined essentially by your ratio?

3 MR. PITLICK: Well, pretty much so. I mean in terms of the other limitations,

4 such as the CTAB surface area range, PT surface area, things of that sort, those

5 generally, by themselves, are conventional, but the important and significant

6 advance here is in the ratio of the Sears number to the BET surface area.

7 And, again, I commend the Board to the decision in that co-pending

8 application because I don't see much daylight between the facts here and the

9 facts there.

10 So if there are any -- any additional questions --

11 JUDGE HASTINGS: Did the co-pending application get allowed yet?

12 MR. PITLICK: You know, I -- I have not checked that. I see that the -- I see

13 that the date, the mail date, of the decision in the other case was August 2nd,

14 so that's fairly recent. I don't know. I have not reviewed the prosecution

15 history since.

16 JUDGE NAGUMO: I did check. It's before the Examiner, docketed earlier

17 this month. So it's still in play.

18 JUDGE WARREN: Any further questions?

19 JUDGE NAGUMO: I have no further questions.

20 JUDGE HASTINGS: No.

21 JUDGE WARREN: Thank you very much, counselor.

22 MR. PITLICK: I would just add one --

23 JUDGE WARREN: Certainly.

24 MR. PITLICK: -- one coda, I suppose. The fact that it may or may not

25 already be patented I don't think is relevant in terms of the issues in this

26 Appeal.

1 JUDGE WARREN: Okay. This proceeding is terminated.

2 Whereupon, the proceedings at 1:27 p.m. were concluded.

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